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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,163	08/07/2001	Thane M. Larson	10012383-1	1476
22879 7590 09/21/2009 HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528				
EXAMINER HUYNH, KIM T				
ART UNIT 2111		PAPER NUMBER		
NOTIFICATION DATE 09/21/2009		DELIVERY MODE ELECTRONIC		

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* THANE M. LARSON and KIRK BRESNIKER

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Appeal 2008-003833  
Application 09/924,163  
Technology Center 2100

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Decided: September 17, 2009

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Before ALLEN R. MACDONALD, JOSEPH L. DIXON, and  
JAY P. LUCAS, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

## I. STATEMENT OF THE CASE

A Patent Examiner rejected claims. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

### A. INVENTION

The invention at issue on appeal provides a server system including a plurality of printed circuit assemblies including at least one host processor card. A management card is coupled to the plurality of printed circuit assemblies. The management card is dedicated to monitoring and managing operation of the server system, including monitoring and managing on-line insertion and removal of the printed circuit assemblies. (Spec. 1.)

### B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A server system comprising:

a plurality of printed circuit assemblies including a plurality of host processor cards;

a management card coupled to the plurality of printed circuit assemblies, the management card dedicated to monitoring and managing operation of the server system, including monitoring and managing on-line insertion and removal of the printed circuit assemblies; and

wherein the management card includes a LAN switch configured to be coupled to the plurality of host processor cards and an external management network.

### C. REFERENCES

The Examiner relies on the following references as evidence:

Bassman	US 6,295,567 B1	Sep. 25, 2001
Wong	US 6,528,904 B1	Mar. 4, 2003
Thornton	US 2004/0225794 A1	Nov. 11, 2004

### D. REJECTIONS

Claims 1-4, 6-10, 12-16, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong in view of Thornton.

Claims 5, 11, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong in view of Thornton and further in view of Bassman.

## II. ISSUE

Have Appellants shown error in the Examiner's initial showing of obviousness of independent claim 1?

## III. PRINCIPLES OF LAW

### 35 U.S.C. § 103(a)

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

*KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 415, and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 415-16 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 417.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 416). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 550 U.S. at 418).

#### IV. ANALYSIS

With respect to independent claim 1, Appellants argue in the Appeal Brief and the Reply Brief that the Examiner has not provided a showing of the express claim limitation "where in the management card includes a LAN switch configured in to be coupled to the plurality of host processor cards and an external management network." (App. Br. 3-4; Reply Br. 2).

The Examiner maintains that Wong discloses all the limitations except "wherein the management card includes a LAN switch configured to [be] coupled to the plurality of host processor cards and an external management network. However, Thorton discloses a LAN interface switching unit which is configurable to route and coded signals from one or more of the plurality of computer cards to one or more LAN devices (external) to the removable function module. (paragraph 24-29)" (Ans. 3.) From our review of those paragraphs in Thorton identified by the Examiner, we find no express teaching of the use of a LAN switch interconnected as recited in the language of independent claim 1. While we may speculate that the data switch of Thorton may be a LAN switch, Thorton does not teach or fairly suggest the data switch in a configuration as recited in independent claim 1, nor has the Examiner provided any discussion as to why it would have been obvious to one of ordinary skill in the art to have specifically configured a LAN switch as recited in the language of independent claim 1. The Examiner merely states in the Answer that incorporating Thorton's teachings into Wong's system would provide improved systems that are desired for adding modular functionality to the co-located computer system. (Ans. 4.) We find that the Examiner's motivation statement to

inappropriately draw a conclusion and further does not address the specific claim language and interconnections as specifically recited and argued by Appellants in the Appeal Brief and the Reply Brief. Therefore, the Examiner has not made the requisite initial showing of obviousness, and we cannot sustain the rejection of independent claim 1 and its dependent claims 2-7.

Independent claims 8 and 14 contain similar limitations to those argued with respect to independent claim 1, and we similarly find that the Examiner has not set forth a proper initial showing of obviousness with respect thereto. Therefore, we cannot sustain the rejection of independent claims 8 and 14 and their respective dependent claims 9-13 and 15-20.

#### V. CONCLUSION

For the aforementioned reasons, the Appellants have shown error in the Examiner's initial showing of obviousness of claims 1-20.

#### VI. ORDER

We reverse the obviousness rejections of claims 1-20.

REVERSED

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Application 09/924,163

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